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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,341	03/23/2000	Anna P. Catania	252/029	9950

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EXAMINER
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PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 11/26/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/533,341**

Applicant(s)  
**Catania, A. And J. Lipton**

Examiner  
**Jeffrey S. Parkin, Ph.D.**

Art Unit  
**1648**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 22 Aug 2001

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-14 is/are pending in the application.

4a) Of the above, claim(s) 1-12 and 14 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 13 is/are rejected.

7) ☒ Claim(s) 13 is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5, 6

20) ☐ Other: \_\_\_\_\_

### Detailed Office Action

#### *Status of the Claims*

1. Applicants' election with traverse of Group V (claim 13) in paper no. 9 is acknowledged. Applicants traverse and assert that an unreasonable number of peptides are not claimed. Moreover, applicants point to § 803.04 of the M.P.E.P. and argue that it  
5 allows for the examination of up to ten different nucleotide sequences. Applicants are advised that this section of the M.P.E.P. is directed toward EST applications containing a large number of short oligonucleotides of unknown function and does not apply to the instant application. Moreover, applicants are further  
10 advised that this section of the M.P.E.P. allows for the examination of single nucleotide or amino acid sequences, particularly when the three-dimensional structure is critical to the function of the protein. Applicants' arguments have been thoroughly considered but are not deemed to be persuasive for the  
15 reasons of record clearly set forth in the last Office action (paper no. 7). Accordingly, **the requirement is still deemed to be proper and is therefore made FINAL.** Claims 1-12 and 14 are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

#### *Claim Objections*

2. Claim 13 is objected to because of the following informalities: the claim fails to reflect the restriction requirement and election set forth in paper nos. 7 and 9. Appropriate correction to reflect  
25 the election is required.

#### *35 U.S.C. § 103(a)*

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office

action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

15 4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a),  
20 the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the  
25 time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

30 5. The criteria that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are set forth in *Graham et al. v. John Deere Company of Kansas City et al.*; *Calmar, Inc. v. Cook Chemical Company*; *Colgate-Palmolive Company v. Same*, 148 U.S.P.Q. 459 (U.S. Sup. Ct. 1966). These factual inquiries can be summarized as follows: 1) Determining the scope and contents of  
35 the prior art. 2) Ascertaining the differences between the prior art and the claims at issue. 3) Resolving the level of ordinary skill in the pertinent art. 4) Considering objective evidence present in the application indicating obviousness or unobviousness

(i.e., commercial success, long felt but unsolved needs, failure of others, etc.).

5 6. Claim 13 is rejected under 35 U.S.C. § 103(a) as being  
unpatentable over Lipton (1992). Lipton teaches that tripeptides  
bearing the amino acid sequence KPV are efficient antipyretic or  
ant inflammatory compounds useful for the treatment of bacterial  
infections (see Abstract). This teaching does not disclose the  
administration of these compounds to HIV-infected patients  
10 suffering from secondary infections. However, it would have been  
*prima facie* obvious to one having ordinary skill in the art at the  
time the invention was made to treat HIV-infected patients  
suffering from secondary infections with the compounds of Lipton  
(1992), since this would reduce the fever and swelling associated  
15 with such opportunistic infections.

#### **Correspondence**


20 7. Correspondence related to this application may be submitted to  
Group 1600 by facsimile transmission. The faxing of such papers  
must conform with the notice published in the Official Gazette,  
1096 OG 30 (November 15, 1989). Official communications should be  
directed toward one of the following Group 1600 fax numbers: (703)  
308-4242 or (703) 305-3014. Informal communications may be  
submitted directly to the Examiner through the following fax  
25 number: (703) 308-4426. Applicants are encouraged to notify the  
Examiner prior to the submission of such documents to facilitate  
their expeditious processing and entry.

30 8. Any inquiry concerning this communication should be directed to  
Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227.  
The examiner can normally be reached Monday through Thursday from  
8:30 AM to 6:00 PM. A message may be left on the examiner's voice  
mail service. If attempts to reach the examiner are unsuccessful,  
the examiner's supervisors, James Housel or Laurie Scheiner, can be  
35 reached at (703) 308-4027 or (703) 308-1122, respectively. Any

Serial No.: 09/533,341  
Applicants: Catania, A., et al.

inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,



Jeffrey S. Parkin, Ph.D.  
Patent Examiner  
Art Unit 1648

17 November, 2001